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10/680,012	10/07/2003	Michael Furst	FURST, M-1	4718

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EXAMINER

SIMONE, CATHERINE A

ART UNIT PAPER NUMBER

1772

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/680,012

Applicant(s)

FURST, MICHAEL

Examiner

Catherine Simone

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 May 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2,7,9,11,14,16-21,24-26 and 28-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,7,9,11,14,16-21,24-26 and 28-31 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Withdrawn Rejections

1. The 35 U.S.C. 103 rejection of claims 1, 2, 9-11, 14, 22, 23 and 28-30 over Stierli in view of Hurst of record in the Office Action mailed 1/26/06, Pages 2-4, Paragraph #3 has been withdrawn due to the Applicant's amendment filed 5/30/06.
2. The 35 U.S.C. 103 rejection of claims 1, 2, 7, 9-11, 14 and 22-26 over Jenkins in view of Hurst of record in the Office Action mailed 1/26/06, Pages 4-6, Paragraph #4 has been withdrawn due to the Applicant's amendment filed 5/30/06.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 7, 9, 11, 14, 16, 18, 20, 21, 24-26 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiercinski et al. (US 5,687,517) in view of Hurst (US 3,900,102).

Regarding claims 1 and 14, Wiercinski et al. discloses a film-bitumen combination comprising at least three layers (Figure 2) wherein the at least three layers comprise a bituminous layer (Fig. 2, #12) and at least two film layers made from different materials (Fig. 2, #22 and #22A and see col. 6, lines 58-64), the bituminous layer being coated on the at least two film layers (see col. 5, lines 54-60), the at least two film layers comprising a first film layer and a second film layer

Art Unit: 1772

produced from a polyolefin, polypropylene, polyamide, polyethylene terephthalate (PET) or polyacrylonitrile (see col. 4, lines 31-36 and col. 6, lines 7-10 and lines 62-64), the first film layer being located further away from the bituminous layer (Fig. 1, #14 and Fig. 2, #22 and/or #22A) and inherently having a larger coefficient of elongation than the second film layer (see col. 6, lines 60-64), since the layers are each made up of materials similar to those materials of the film layers disclosed in Applicant's present Specification. Additionally, Wiercinski et al. discloses a surface of a side of the combination facing away from the bituminous layer having been treated to have non-slip properties (see col. 4, lines 1-16 and col. 6, lines 46-50), and each individual film layer is arranged in the combination in accordance with its thermal stability and its mechanical strength (see col. 4, lines 11-30 and col. 5, lines 14-17). However, Wiercinski et al. fails to disclose a first edge of the at least two film layers projecting beyond the bituminous layer and a second edge of the at least two film layers being shorter than the bituminous layer.

Hurst teaches that it is old and well known in the art to have a first edge of a film layer (Fig. 1, #2 at 10) project beyond a bituminous layer (Fig. 1, #4) and the second edge of the film layer be shorter (Fig. 1, #2 at 8) than the bituminous layer (Fig. 1, #4; also see col. 8, line 67 to col. 9, line 3) for the purpose of forming a continuous membrane which does not contain and is not susceptible to the formation of channels for the flow or collection of water and is highly resistant to damage during installation and failure thereafter when joined with other bituminous/film strips and laminated to a substrate.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the edges of the two film layers in Wiercinski et al. to have the first edge of the film layers project beyond the bituminous layer and the second edge of the film layers be shorter than the bituminous layer as suggested by Hurst in order to form a

Art Unit: 1772

continuous membrane which does not contain and is not susceptible to the formation of channels for the flow or collection of water and is highly resistant to damage during installation and failure thereafter when joined with other bituminous/film strips and laminated to a substrate.

Regarding claim 2, the at least two film layers in Wiercinski inherently have different coefficients of thermal expansion (see col. 3, lines 49-53 and col. 6, lines 61-64), since the layers are each made up of materials similar to those materials of the film layers disclosed in Applicant's present Specification. Regarding claim 7, in Wiercinski the PET layer is oriented (see col. 4, lines 62-63). Regarding claim 9, in Wiercinski the at least two film layers (Fig. 2, #22 and #22A) are laminated to a bituminous layer (Fig. 2, #12) individually or together. Regarding claim 11, note in Wiercinski at least one film layer facing the bituminous layer provides a mineral oil barrier (see col. 6, lines 59-64). Regarding claim 16, note in Wiercinski the non-slip treatment is carried out by means of coating (see col. 6, lines 46-50). Regarding claim 18, note in Wiercinski the non-slip treatment is carried out by means of at least partial embossing of the surface (see col. 3, lines 62-65). Regarding claim 20, note in Wiercinski the non-slip treatment is provided by a coextruded syndiotactic polystyrene film (see col. 4, line 37). Regarding claim 21, note in Wiercinski the non-slip treatment is provided by a thermoplastic elastomer with a metallocene complex (see col. 4, line 37 and col. 6, lines 50-57). Regarding claim 24, note in Wiercinski a tie layer or an adhesive disposed between two adjacent layers of the at least two film layers (see col. 5, lines 18-19). Regarding claim 25, note in Wiercinski a barrier layer against mineral oils disposed between two adjacent layers of the at least two film layers (see col. 6, lines 59-64). Regarding claim 26, the barrier layer in Wiercinski comprises a layer of lacquer (see col. 6, lines 60-64). Regarding claim 28, note in Wiercinski the bituminous layer (Fig. 3, #12) has a surface facing away from the at least two film layers (Fig. 3, #22

Art Unit: 1772

and #22A) and a release liner is provided on the surface (Fig. 3, #40). Regarding claims 29 and 30, note the release liner in Wiercinski is siliconized paper (see col. 3, lines 1-2).

5. Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiercinski et al. (US 5,687,517) in view of Hurst (US 3,900,102) and further in view of Zickell et al. (US 4,992,315).

Wiercinski et al. and Hurst teach the film-bitumen combination as shown above. However, Wiercinski et al. fails to disclose the non-slip coating and the embossing being shorter at least along one edge of the combination. Zickell et al. teaches that it is old and well-known in the art to have an embossed non-slip film (Fig. 3, #28) being shorter along at least one edge of a film-bitumen combination for the purpose of providing a small portion having slip resistance where one can stand to reduce the risk of falling (see col. 4, lines 63-66). Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the non-slip coating and embossing in Wiercinski et al. to be shorter at least along one edge of the combination as suggested by Zickell et al. in order to provide only a portion that is slip resistant where one can stand to reduce the risk of falling.

6. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiercinski et al. (US 5,687,517) in view of Hurst (US 3,900,102) and further in view of Kalkanoglu (US 4,757,652).

Wiercinski et al. and Hurst teach the film-bitumen combination as shown above. However, Wiercinski et al. fail to disclose the release liner having several sections. Kalkanoglu teaches that it is old and well-known in the analogous art to have a release liner with several sections for the purpose of allowing the material to be flopped back, so that one side can be stuck, and then the other side can be flopped down and stuck (see col. 1, lines 5-10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the release

Art Unit: 1772

liner in Wiercinski et al. to have several sections as suggested by Kalkanoglu in order to allow the material to be flopped back, so that one side can be stuck, and then the other side can be flopped down and stuck.

Response to Arguments

7. Applicant's arguments filed 5/30/06 have been fully considered but they are not persuasive.

Applicant argues "Wiercinski et al. simply discloses a roofing underlayment including a pressure-sensitive membrane adhesive layer 12 attached to a carrier support sheet 14. There is no disclosure or suggestion in Wiercinski et al. of arranging individual film layers in the combination in accordance with their thermal stability and their mechanical strength".

However, in column 4, lines 11-30, Wiercinski et al. clearly teaches each individual film layer being arranged in the combination in accordance with its thermal stability and its mechanical strength. Furthermore, it is to be pointed out that the two film layers (22 and 22A) in Wiercinski et al. are made up of *different* materials and are arranged to provide better dimensional stability (see col. 4, lines 11-30), and the materials that make up the film layers are similar to those that make up the film layers disclosed in Applicant's present application (see col. 4, lines 31-36). Therefore, each individual film layer in Wiercinski et al. is inherently arranged in the combination in accordance with its thermal stability and its mechanical strength. Thus, the claims fail to patentably define over the prior art as applied above.

Furthermore, Applicant argues "the defects and deficiencies of the primary reference to Wiercinski et al. are nowhere remedied by the secondary reference to Hurst. Hurst simply

Art Unit: 1772

discloses a waterproofing means and method including a sheet-like substrate and contiguous thereto a membrane of a water-proofing pressure-sensitive adhesive. There is no disclosure or suggestion of Applicant's film-bitumen combination as set forth in amended claim 1 or of arranging each individual film layer in the combination in accordance with its thermal stability and its mechanical strength".

However, as pointed out above, Wiercinski et al. clearly teaches each individual film layer being arranged in the combination in accordance with its thermal stability and its mechanical strength (see col. 4, lines 11-30). Thus, the claims fail to patentably define over the prior art as applied above.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 1772

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571)272-1501.

The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Catherine A. Simone
Examiner
Art Unit 1772
August 10, 2006



RENA DYE
SUPERVISORY PATENT EXAMINER

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